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EXAMINER

HYLTON, ROBIN ANNETTE

ART UNIT PAPER NUMBER

3727

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/889,006
Filing Date: October 15, 2001
Appellant(s): ZOLLER ET AL.

Leonard J. Santisi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 24, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 7-9 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

GB 1,545,469

SHARP

5-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-9 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on August 19, 2003.

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(11) Response to Argument

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the pack is for pouring contents therefrom) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument that pack of Sharp is not intended to allow pouring, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the pack of Sharp is not set forth as dispensing or pouring the contents therefrom in the manner intended by appellant. However, it is asserted the contents (i.e., the inner pack 13) can in fact be dispensed from the pack by tilting the pack in the known manner of dispensing. In the same manner the claims of the instant application set forth a pack having at least one holding and carrying handle comprising at least one flap and a plurality of pack faces, with the handle fitted to one of the pack faces along an axis of symmetry at an angle to a plane parallel to the pack face, the patent to Sharp discloses the same pack.

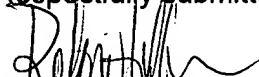
The written specification of Sharp does not teach a specific angle for orienting the handle. Therefore, the motivation to select an angle of orientation is not found therein, but rather in the drawings. Thus, the drawings must be utilized to determine an angle of inclination of the handle with respect to a pack face.

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To the degree the claims of the instant applicant do not set forth a specific plane of reference, any plane can be established to show the handle of Sharp is oriented an angle of 2-10 degrees with respect to the pack face and/or has an angle of inclination of 30°. Thus, Sharp provides the motivation or suggestion to orient the handle with respect to a selected pack face.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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RAH
December 13, 2004

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